methyl groups and R_{11} is a benzyl group.

6. (Amended) The compound as defined in claim 1, wherein R_2 is a methoxyl group, R_3 is a hydroxy group, R_1, R_4, R_5, R_7, R_8, R_9, R_{10} and R_{13} are hydrogen atoms, R_6 and R_{13} are methyl groups and R_{11} is a p-hydroxy benzyl group.

25. (Amended) The compound as defined in claim 1, wherein when R_6 and R_7 differ, the carbon atom to which R_6 is linked in said formula is in the (R), (S) or (RS) configuration.

BASIS FOR THE AMENDMENT

Claims 1, 4, 6, and 25 have been amended.

The amendment of Claim 1 is supported by Claim 1 as originally filed, page 2, line 2 to page 4, line 2, and the structure of formula 1. The amendment of Claims 4 and 6 is supported by the claims as originally filed and serve to correct obvious typographical errors. The amendment of Claim 25 is supported by the structure of formula 1 and the specification at page 3, line 2 to page 4, line 2. The specification has also been amended to clarify the structure of formula 1 and to correct an inadvertent error in the proviso.

No new matter is believed to have been entered by the present amendment.

REMARKS

Claims 1-34 are pending in the present application.

At the outset, Applicants wish to thank Examiner Oh and Examiner Rotman for the helpful and courteous discussion conducted with their undersigned U.S. Representative on January 29, 2003. In addition, Applicants wish to thank Examiner Oh for the indication that the amendment to Claim 1 to clarify the nature of the bonds to the propylene moiety in the structure of formula 1 would "avoid the 112 problems, such as the (R), (S), or (RS)

configuration, and double patenting rejections, and 102 rejection" (see paper number 11). In accordance with the remarks made during the discussion, the claims have been amended to clarify the present invention. Now, Applicants wish to make the following additional remarks.

The rejection of Claims 1, 4, 6, and 10 under 35 U.S.C. §102(b) over Nofre et al is traversed.

In paper number 10 (page 5, lines 2-4), the Examiner points to the structure appearing at column 5, lines 15-25 and asserts that this compound disclosed by Nofre et al is "identical with the claims." However, Applicants disagree with this assertion. In particular, Applicants draw the Examiner's attention to the first proviso in present Claim 1, which stipulates that R_6, R_7, R_8, R_9 and R_{10} *cannot* be hydrogen atoms at the same time. This proviso absolutely excludes the compound disclosed by Nofre et al at column 5, lines 15-25 in which R_6, R_7, R_8, R_9 and R_{10} *must* be hydrogen atoms at the same time.

Applicants note that at no point does Nofre et al disclose or suggest any compound that would read on the presently claimed N-alkylaspartyl dipeptide ester compounds, especially when taking into account the three provisos. Moreover, Nofre et al do not provide any reasonable expectation of the attendant advantages flowing from the presently claimed N-alkylaspartyl dipeptide ester compounds. As such, Applicants submit that the present invention is not anticipated by or obvious in view of the disclosure by Nofre et al.

During the discussion with Applicants undersigned Representative, the Examiner indicated that the distinction between the present invention and the disclosure of Nofre et al is understood and that this ground of rejection should be withdrawn in view of the amendment to formula (1) presented herein (see paper number 11).

Accordingly, Applicants request withdrawal of this ground of rejection.

The rejection of Claims 2, 6, 26-28 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

Applicants wish to thank Examiner Oh for the indication that the rejection of Claims 26-28 would be withdrawn upon clarification of the structure in formula (1), specifically with respect to the bonds to R_6-R_{10} (see paper number 11).

Withdrawal of this ground of rejection is requested.

The obviousness double patenting rejections of Claims 1-25 over U.S. Patent Application No. 09/864,940 and over U.S. Patent Application No. 09/736,149 are traversed. Specifically, Applicants point to the first proviso in present Claim 1, which excludes a scenario where R_6, R_7, R_8, R_9 and R_{10} are hydrogen atoms at the same time. Inspection of Claim 1 in each of U.S. Patent Application No. 09/864,940 and over U.S. Patent Application No. 09/736,149 reveal that claims of these patent applications are exclusively drawn to that which this proviso absolutely excludes. During the discussion with Applicants undersigned Representative, the Examiner indicated that this distinction is understood and that this ground of rejection should be withdrawn in view of the amendment to formula (1) presented herein (see paper number 11).

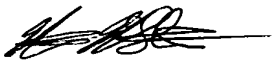
Applicants respectfully request withdrawal of the obviousness double patenting rejections of Claims 1-25 over U.S. Patent Application No. 09/864,940 and over U.S. Patent Application No. 09/736,149.

A

Applicants submit that the present application is in condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Vincent K. Shier, Ph.D.
Registration No. 50,552

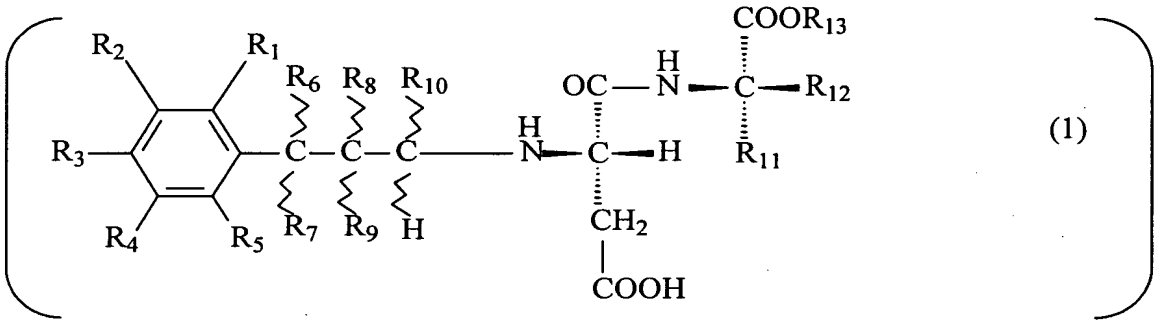
22850
Tel.: (703) 413-3000
Fax: (703) 412-2220
NFO:VKS

MARKED-UP COPY

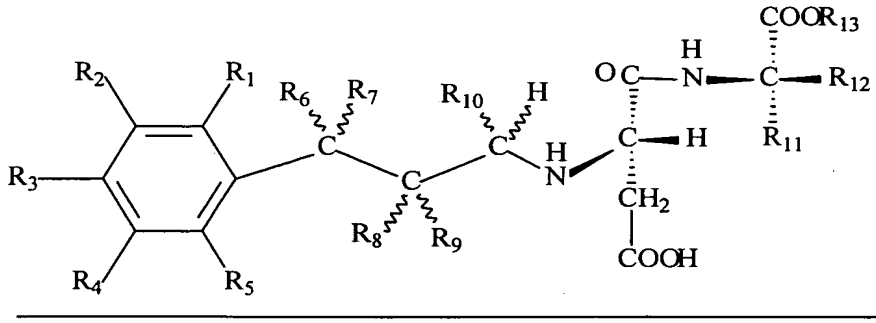
IN THE SPECIFICATION

Please replace the paragraph beginning on page 3, line 2 with the following text:

Accordingly, one object of the present invention is an N-alkylaspartyl dipeptide ester compound, and salts thereof, represented by formula (1):



(1)



wherein R_1, R_2, R_3, R_4 and R_5 are independent from each other, selected from the group consisting of a hydrogen atom, a hydroxyl group, an alkoxy group having 1 to 3 carbon

atoms, an alkyl group having 1 to 3 carbon atoms and a hydroxy alkyloxy group having two or three carbon atoms, and R_1 and R_2, or R_2 and R_3, optionally, form a methylene dioxy group, and R_4 and R_5, and R_1 or R_3 which do not form the methylene dioxy group are defined as above;

R_6, R_7 , R_8, R_9 and R_{10} are independent from each other, a hydrogen atom or an alkyl group with 1 to 3 carbon atoms; and optionally, two of R_6, R_7, R_8, R_9 and R_{10} may combine to form an alkylene group with 1 to 5 carbon atoms, and R_6, R_7, R_8, R_9 and R_{10} which do not form the alkylene group with 1 to 5 carbon atoms are defined as above;

R_{11} is selected from the group consisting of a hydrogen atom, a benzyl group, a p-hydroxy benzyl group, a cyclohexyl methyl group, a phenyl group, a cyclohexyl group, a phenyl ethyl group and a cyclohexyl ethyl group;

R_{12} is selected from the group consisting of a hydrogen atom and an alkyl group with 1 to 3 carbon atoms; and

R_{13} is selected from the group consisting of alkyl groups with 1 to 4 carbon atoms;

with the proviso that the following are excluded:

where R_6, R_7, R_8, R_9 and R_{10} are a hydrogen atom at the same time,

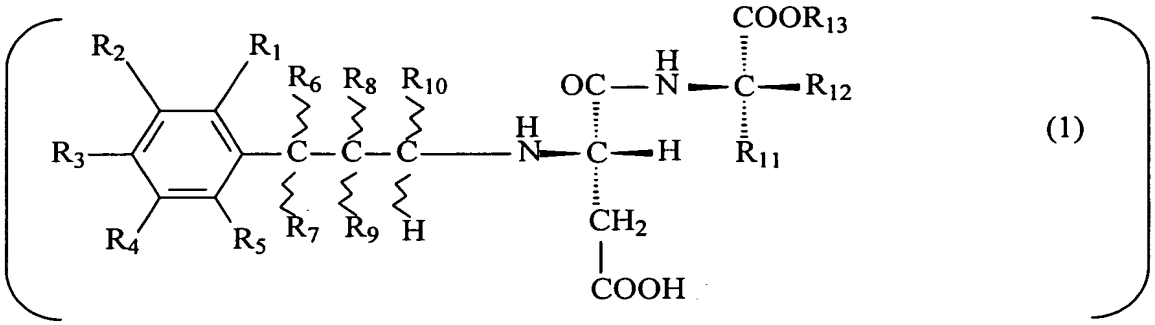
where R_6 is a methyl group, R_1, R_2, R_3, R_4, R_5, R_7, R_8, R_9, R_{10} and R_{12} are a hydrogen atom at the same time and R_{11} is a benzyl group or a p-hydroxy benzyl group, at the same time; and

where R_2 or R_4 [are] <u>is a</u> methoxy [groups] <u>group</u>, R_3 is a hydroxyl group, R_{10} is a methyl group, R_1, R_4 <u>or R_2</u>, R_5, R_6, R_7, R_8 and R_9 are hydrogen atoms at the same time, and R_{11} is a benzyl group or a p-hydroxy benzyl group.

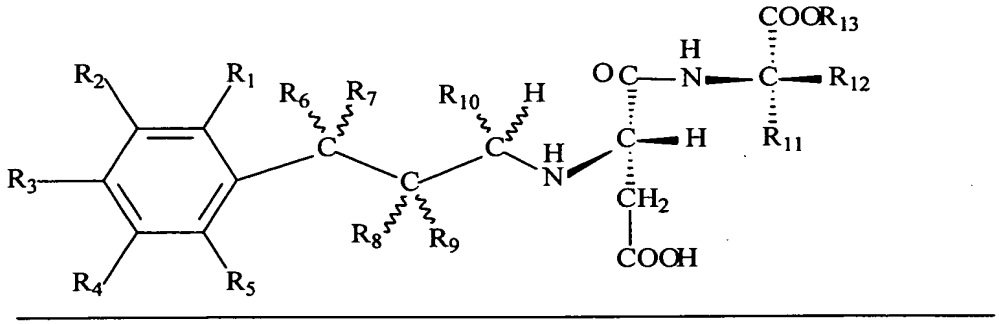
IN THE CLAIMS

Please amend the claims as follows:

1. (Amended) An N-alkylaspartyl dipeptide ester compound, and salts thereof, represented by the formula (1):



(1)



wherein R_1, R_2, R_3, R_4 and R_5 are independent from each other, selected from the group consisting of a hydrogen atom, a hydroxyl group, an alkoxy group having 1 to 3 carbon atoms, an alkyl group having 1 to 3 carbon atoms and a hydroxy alkyloxy group having two or three carbon atoms, and R_1 and R_2, or R_2 and R_3, optionally, form a methylene dioxy group, and R_4 and R_5, and R_1 or R_3 which do not form the methylene dioxy group are defined as above;

R_6, R_7 , R_8, R_9 and R_{10} are independent from each other, a hydrogen atom or an alkyl group with 1 to 3 carbon atoms; and optionally, two of R_6, R_7, R_8, R_9 and R_{10} may combine to

form an alkylene group with 1 to 5 carbon atoms, and R_6, R_7, R_8, R_9 and R_{10} which do not form the alkylene group with 1 to 5 carbon atoms are defined as above;

R_{11} is selected from the group consisting of a hydrogen atom, a benzyl group, a p-hydroxy benzyl group, a cyclohexyl methyl group, a phenyl group, a cyclohexyl group, a phenyl ethyl group and a cyclohexyl ethyl group;

R_{12} is selected from the group consisting of a hydrogen atom and an alkyl group with 1 to 3 carbon atoms; and

R_{13} is selected from the group consisting of alkyl groups with 1 to 4 carbon atoms;

with the proviso that the following are excluded:

where R_6, R_7, R_8, R_9 and R_{10} are hydrogen atoms at the same time,

where R_6 is a methyl group, R_1, R_2, R_3, R_4, R_5, R_7, R_8, R_9, R_{10} and R_{12} are a hydrogen atom at the same time and R_{11} is a benzyl group or a p-hydroxy benzyl group, at the same time; and

where R_2 or R_4 [are] <u>is a</u> methoxy [groups] <u>group</u>, R_3 is a hydroxyl group, R_{10} is a methyl group, R_1, R_4 <u>or R_2</u>, R_5, R_6, R_7, R_8 and R_9 are hydrogen atoms at the same time, and R_{11} is a benzyl group or a p-hydroxy benzyl group.

2. (Amended) The compound as defined in claim 1, wherein R_3 is a methoxy group, R_1, R_2, R_3, R_4, R_5, [R_6,] R_7, R_8, R_9, R_{10} and R_{12} are hydrogen atoms, R_6 and R_{13} are methyl groups and R_{11} is a benzyl group.

4. (Amended) The compound as defined in claim 1, wherein R_2 is a methoxy group, R_3 is a hydroxyl group, R_1, R_4, R_5, R_7, R_8, R_9, R_{10} and R_{12} [arehydrogen] <u>are hydrogen</u> atoms, R_6 and R_{13} are methyl groups and R_{11} is a benzyl group.

6. (Amended) The compound as defined in claim 1, wherein R_2 is a methoxyl group, R_3 is a hydroxy group, R_1, R_4, R_5, R_7, R_8, R_9, R_{10} and R_{13} [arehydrogen] <u>are hydrogen</u> atoms,

R_6 and R_{13} are methyl groups and R_{11} is a p-hydroxy benzyl group.

25. (Amended) The compound as defined in claim 1, wherein when R_6 and R_7 differ, the carbon atom to which [R_8] $\underline{R_6}$ is linked in said formula is in the (R), (S) or (RS) configuration.